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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/775,638	02/05/2001	Manfred Dombek	31512-168230 RK	8302

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EXAMINER

LOPEZ, CARLOS N

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 12/04/2002

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/775,638

Applicant(s)

DOMBEK, MANFRED

Examiner

Carlos Lopez

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 11-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 February 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,5,9. 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of the invention elected in Paper No. 12 is acknowledged. The traversal is on the ground(s) that Group III, claims 16-20, is a linking claim and must be examined with the elected invention of Group I, claims 1-10. This is not found persuasive because the apparatus discloses a rolling and feeding apparatus limitations not required by method claims of Group I. Nor the claimed method of Group I require the structural limitations of Group III or the method limitations performed by the rolling and feeding devices of Group III.

The requirement is still deemed proper and is therefore made FINAL.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 50' in Figure 3. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

Claims 2, 3, 6-10 are objected to because of the following informalities:
Underlining of elements "m", "n", "p", "q", and "x" to an unmarked-up claim in its clean version. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for changing the permeability of rod shaped products of the tobacco industry, does not reasonably provide enablement for gum wrappers, candy wrappers and/or cd wrappers. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. The term " wrapper of a plurality of products" encompasses a wide range of different wrappers such as candy or gum wrappers not enabled by the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The terms "the permeability", "the tobacco", and "the step" lack antecedent basis in claim 1. In claim 2, "said perforating step" lacks antecedent basis. In claim 5 reciting "the product" and "moving product, it is unclear which product is being referred to, the "rod-shaped product" or to the "plurality of products"?

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Mattei et al (US 4,720,619). Mattei discloses a method for perforating the wrappers of rod shaped products of the tobacco industry (Abstract). As shown in figure 2, parallel laser beams 9-11 are changing the permeability of wrappers of a plurality of rod shaped products simultaneously. As for claim 2, in figure 1 the wrappers of three products are being perforated. As for claim 7, the laser beam perforates one portion of various angle sectors of the rod shaped product is perforated.

Claims 1, 2, and 7-9 are rejected under 35 U.S.C. 102(a) as being anticipated by Voss et al (US 6,064,032). Voss discloses a method for perforating the wrappers of rod shaped products of the tobacco industry (Abstract). As shown in figure 2, four parallel laser beams 46c are changing the permeability of wrappers that would be the wrappers of two rod shaped products (Column 2, lines 10-15, and lines 44-61). As for claim 2, in figure 2 the wrappers of two products are being perforated. As for claim 7-9, the laser beam perforates two portions of each of the wrappers of the rod shaped products by directing two laser beams to each wrapper.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mattei et al (US 4,720,619). Claim 3 additionally recites an oscillatable beam reflecting mirror. Mattei's laser source 5, establishes at least two parallel laser beams which are directed to at least one oscillatable beam reflecting faces 26 to focus at least two laser beams to the wrappers of at least one product (Figure 2). Mattei is silent disclosing an oscillatable beam reflecting mirror as recited in claim 3. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art that oscillatable beam reflecting faces 26 would include mirrors. As for claim 5, the reflecting surfaces 26 is rotated to thus focus the beams using lenses 27 to pierce the wrappers of other products (2) being moved by roller (1) (Column 3, lines 30-47).

Allowable Subject Matter

Claim 10 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph and objections recited above as set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The cited prior art does not disclose or reasonably suggest of simultaneously changing permeability of a plurality of wrappers by perforating at least 2 portions of a

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wrapper by directing at least 2 laser beams to each wrapper using partially reflecting and fully reflecting mirrors as recited in claim 10.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Lopez whose telephone number is (703) 605-1174. The examiner can normally be reached on Mon.-Fri. 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on (703) 308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7718 for regular communications and (703) 305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

C.L
November 27, 2002



SEAN VINCENT
PRIMARY EXAMINER